



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|----------------------|------------------|
| 10/749,164 | 12/30/2003 | Zbigniew Tokarski | 3216.36US02 | 7875 |
| 24113 | 7590 | 03/06/2006 | EXAMINER | |
| PATTERSON, THUENTE, SKAAR & CHRISTENSEN, P.A. 4800 IDS CENTER 80 SOUTH 8TH STREET MINNEAPOLIS, MN 55402-2100 | | | RODEE, CHRISTOPHER D | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 1756 | |

DATE MAILED: 03/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|-------------------------------|---------------------------------|--|
| Office Action Summary | Application No. 10/749,164 | Applicant(s) TOKARSKI ET AL. | |
| | Examiner Christopher RoDee | Art Unit 1756 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 January 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 and 23-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1,3-8 and 10-14 is/are allowed.
- 6) ☒ Claim(s) 2, 9, and 23-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

Claims 2, 9, and 24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 2, 9, and 24 are also indefinite because it is unclear if Y' is limited to the recited atoms or group noting the "may be" language. It is unclear if other atoms or groups are permitted than those recited. This rejection was set forth in the last Office action (p. 4, top). No specific remarks or amendments have been presented to address the rejection. Consequently, the rejection is retained.

Claim Rejections - 35 USC § 102

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 23-26 are rejected under 35 U.S.C. 102(e) as being anticipated by Tokarski *et al.* in US Patent Application Publication 2004/0170910.

This rejection was presented in the last Office action. Applicants traverse the rejection because prior invention by the present inventors as well as derivation by the inventors of the '910 application are shown by the evidence of record. Specifically, applicants take the position that dimers of the '910 publication are derivative work as evidenced by the provisional application of the instant application. The epoxy group-containing compound in the '910 publication is not prior to the 119(e) provisional application of the instant application. The dimer

Art Unit: 1756

compounds are based upon or formed from the epoxy terminated compounds disclosed in the provisional application of the instant application. The '910 application is a derivative of applicant's own work. Consequently, the applied publication is not prior art.

The Examiner has carefully considered applicants' remarks and has reviewed the applied publication, the instant claims, and the priority documents of both this application and the prior application. Applicants appear to traverse the rejection on two points: 1) the priority document of the instant application shows prior invention of the claimed subject matter, and 2) the subject matter of the '910 application is derivative of applicants own work. Applicants can properly traverse the rejection on either basis. However, the evidence of record is not sufficient to accomplish either.

With respect to the section 119(e) priority claim, MPEP 201.11(I)(A) is pertinent. This section states,

"Under 35 U.S.C. 119(e), the written description and drawing(s) (if any) of the provisional application must adequately support and enable the subject matter claimed in the nonprovisional application that claims the benefit of the provisional application. In *New Railhead Mfg., L.L.C. v. Vermeer Mfg. Co.*, 298 F.3d 1290, 1294, 63 USPQ2d 1843, 1846 (Fed. Cir. 2002), the court held that for a nonprovisional application to be afforded the priority date of the provisional application, "the specification of the provisional must contain a written description of the invention and the manner and process of making and using it, in such full, clear, concise, and exact terms,' 35 U.S.C. § 112 ¶1, to enable an ordinarily skilled artisan to practice the invention claimed in the nonprovisional application."

As discussed in the last Office action, the provisional application for the instant application does not meet this requirement. The instant application's priority document shows

Art Unit: 1756

that it does not describe the subject matter of the instant claims because the priority document only discloses the claimed compounds where where R_1 , R_2 , R_3 , and R_4 are, independently, an alkyl group, an alkaryl group, or an aryl group, X is a trivalent aromatic radical, Y is O, S, or N- R_5 where R_5 is hydrogen, an alkyl group, an alkaryl group, or an aryl group, and Z is an epoxy group. Even a cursory review of the instant claims shows that they encompass a far larger group of compounds than is described by the priority document. The priority document does not describe and enable the claims within the meaning of § 112 ¶1. Consequently, the above rejected claims are not entitled to the earlier filing date of the § 119(e) priority claim.

However, the provisional application for the '910 application does disclose and support the subject matter relied upon to make the rejection in compliance with § 112 ¶1. See MPEP 2136.03(III). The pertinent portion of the '910 publication is described by its § 119(e) priority document at page 17 (also see MPEP 706.02(f)(1)). The reference has an earlier effective date because of this 119(e) priority claim and is available as prior art under § 102(e) noting this date and the difference in inventive entities (see MPEP 2163.04).

Thus the publication is available as prior art under § 102(e) based upon the earlier disclosure in the § 119(e) priority document.

With respect to applicants' position that subject matter of the '910 publication was derived from the inventors of the instant application, the Rules provide a mechanism to make such as showing. 37 CFR 1.132 provides for a declaration that any invention disclosed but not claimed in the reference may be shown to be derived from the inventor of the instant application and is thus not the invention "by another". However, the mechanism for this showing must be by way of a declaration or oath. As discussed in MPEP 2136.05,

"When a prior U.S. patent, U.S. patent application publication, or international application publication is not a statutory bar, a 35 U.S.C. 102(e) rejection can be

Art Unit: 1756

overcome by antedating the filing date (see MPEP § 2136.03 regarding critical reference date of 35 U.S.C. 102(e) prior art) of the reference by submitting an affidavit or declaration under 37 CFR 1.131 or by submitting an affidavit or declaration under 37 CFR 1.132 establishing that the relevant disclosure is applicant's own work. In re Mathews, 408 F.2d 1393, 161 USPQ 276 (CCPA 1969)."

No affidavit or declaration has been submitted to establish that the applied publication is applicants' own work; that is, that there is no difference in inventive entities. Lacking such a showing the rejection must be maintained.

Allowable Subject Matter

Claims 2 and 9 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Claims 1, 3-8, and 10-14 are allowed.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

Art Unit: 1756

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher RoDee whose telephone number is 571-272-1388. The examiner can normally be reached on most weekdays from 6:00 to 4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Huff can be reached on 571-272-1385. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

cdr
28 February 2006



CHRISTOPHER RODEE
PRIMARY EXAMINER